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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,457

08/25/2006

Petra Cirpus

13987-00020-US

8604

23416

7590

01/05/2011

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EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

01/05/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/590,457

Applicant(s)

CIRPUS ET AL.

Examiner

Elizabeth F. McElwain

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-6, 10-14 and 64-66.  
Claim(s) withdrawn from consideration: 7-9, 15-35, 38-44 and 47-63.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Elizabeth F. McElwain/  
Primary Examiner, Art Unit 1638

Continuation of 11. does NOT place the application in condition for allowance because: Applicants assert that finality of the last office action should be withdrawn given that new grounds of rejection were made, which applicants argue were not necessitated by amendment of the claims, asserting that the amendments further narrow the scope of the claims. The Examiner strongly disagrees given that the new grounds of rejection are based on the amendment of the claims specifying that the delta-5 elongase "elongates only unsaturated C20 fatty acids". The Examiner is not required to set forth rejections in a first office action on every possible limitation that might be later added to narrow a broad claim.

In addition, applicants request rejoinder of withdrawn claims 7-9. However, the Examiner maintains that the appropriate time for requesting rejoinder has passed and rejoinder of these claims would raise new issues. The restriction requirement is maintained.

Applicants assert that they will consider filing a terminal disclaimer upon indication of allowable claims. However, the Examiner maintains that the claims will not be allowable until a terminal disclaimer is filed.

Applicants assert that the specification discloses 20 delta-5 elongases and therefore this satisfies the written description requirement. The Examiner maintains that the claims are drawn to delta-5 elongases that elongate only unsaturated C20-fatty acids. The Examiner maintains that the specification does not teach 20 delta-5 elongases having activity that elongates only unsaturated C20-fatty acids. The Examiner maintains that the specification only teaches one delta-5 elongase coding sequence that has this specific activity in a plant, while 3 have the claimed activity when expressed in yeast. And the specification fails to describe the structural features that distinguish a delta-5 elongase having activity that elongates only unsaturated C20-fatty acids from other delta-5 elongases that have different specificities.

Applicants assert that the specification is enabling in providing 24 delta-5 elongases, with four that are shown to have the recited activity. In addition methods of cloning are provided and would require only routine experimentation. The Examiner maintains that the specification only discloses one construct that when transformed into a plant elongates C20 fatty acids to produce C22 fatty acids, while there are numerous sequences that may be considered delta-5 elongases that do not have the claimed specific activity, as previously stated, and the claims are broadly drawn to a method of using of any sequence having the claimed delta-5 elongase activity that is specific for C20 fatty acids and in combination with other genes for transformation of any plant species for the production of a broad range of compounds that range from 9 carbons to 31 carbons and having from 2 double bonds to 6 double bonds and the combined levels comprising at least 20% by weight of the lipid content, and it would require undue experimentation to practice the invention as broadly claimed, as stated in the last office action.